

# PATENT COOPERATION TREATY

## PCT

### INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference <b>P1109PC00</b>	<b>FOR FURTHER ACTION</b>		See item 4 below
International application No. <b>PCT/DE2004/002178</b>	International filing date (day/month/year) <b>27 September 2004 (27.09.2004)</b>	Priority date (day/month/year) <b>30 September 2003 (30.09.2003)</b>	
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237			
Applicant <b>EPIGENOMICS AG#</b>			

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 bis.1(a).

2. This REPORT consists of a total of 5 sheets, including this cover sheet.  
In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

3. This report contains indications relating to the following items:

<input checked="" type="checkbox"/>	<b>Box No. I</b>	Basis of the report
<input type="checkbox"/>	<b>Box No. II</b>	Priority
<input type="checkbox"/>	<b>Box No. III</b>	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
<input type="checkbox"/>	<b>Box No. IV</b>	Lack of unity of invention
<input checked="" type="checkbox"/>	<b>Box No. V</b>	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
<input type="checkbox"/>	<b>Box No. VI</b>	Certain documents cited
<input type="checkbox"/>	<b>Box No. VII</b>	Certain defects in the international application
<input type="checkbox"/>	<b>Box No. VIII</b>	Certain observations on the international application

4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis.2).

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The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland	Date of issuance of this report <b>03 July 2006 (03.07.2006)</b>
Facsimile No. +41 22 338 82 70	Authorized officer <b>Agnes Wittmann-Regis</b> e-mail: <a href="mailto:pt06@wipo.int">pt06@wipo.int</a>

# PATENT COOPERATION TREATY

From the  
INTERNATIONAL SEARCHING AUTHORITY

To:

**PCT**

## WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

To:		Date of mailing (day/month/year)	<b>See form PCT/ISA/210</b>
Applicant's or agent's file reference <b>P1109PC00</b>		FOR FURTHER ACTION See paragraph 2 below	
International application No. <b>PCT/DE2004/002178</b>	International filing date (day/month/year) <b>27.09.2004</b>	Priority date (day/month/year) <b>30.09.2003</b>	
International Patent Classification (IPC) or both national classification and IPC <b>C12Q1/68</b>			
Applicant <b>EPIGENOMICS AG</b>			

<p>1. This opinion contains indications relating to the following items:</p> <p><input checked="" type="checkbox"/> Box No. I Basis of the opinion</p> <p><input type="checkbox"/> Box No. II Priority</p> <p><input type="checkbox"/> Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p><input type="checkbox"/> Box No. IV Lack of unity of invention</p> <p><input checked="" type="checkbox"/> Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</p> <p><input type="checkbox"/> Box No. VI Certain documents cited</p> <p><input type="checkbox"/> Box No. VII Certain defects in the international application</p> <p><input type="checkbox"/> Box No. VIII Certain observations on the international application</p>
<p>2. <b>FURTHER ACTION</b></p> <p>If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.</p> <p>If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.</p> <p>For further options, see Form PCT/ISA/220.</p> <p>3. For further details, see notes to Form PCT/ISA/220.</p>

Name and mailing address of the ISA/EP	Authorized officer
Facsimile No.	Telephone No.

Translation

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WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

International application No.  
PCT/DE2004/002178

Box No. I	Basis of this opinion
<p>1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.</p> <p><input type="checkbox"/> This opinion has been established on the basis of a translation from the original language into the following language which is the language of a translation furnished for the purposes of international search (under Rule 12.3 and 23.1(b)).</p> <p>2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:</p> <p>a. type of material</p> <p><input checked="" type="checkbox"/> a sequence listing</p> <p><input type="checkbox"/> table(s) related to the sequence listing</p> <p>b. format of material</p> <p><input checked="" type="checkbox"/> in written format</p> <p><input checked="" type="checkbox"/> in computer readable form</p> <p>c. time of filing/furnishing</p> <p><input checked="" type="checkbox"/> contained in the international application as filed.</p> <p><input type="checkbox"/> filed together with the international application in computer readable form</p> <p><input checked="" type="checkbox"/> furnished subsequently to this Authority for the purposes of search.</p> <p>3. <input checked="" type="checkbox"/> In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.</p> <p>4. Additional comments:</p>	

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Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims 1-12	YES
	Claims _____	NO
Inventive step (IS)	Claims _____	YES
	Claims 1-12	NO
Industrial applicability (IA)	Claims 1-12	YES
	Claims _____	NO

2. Citations and explanations:

Methods which enable the methylation status of a nucleic acid to be determined have been described previously in the prior art. D1 describes a method which enables methylated and unmethylated CpG to be distinguished by a chemical treatment and which is therefore suitable for the diagnosis and prognosis of diseases.

D2 likewise describes a method which enables methylated CpG to be distinguished from unmethylated CpG, see claim 1. D2 therefore provides a method of evaluating cancers, see column 3, lines 28-33. D3, a document from the field of hemimethylations, describes an amplification method which enables hemimethylated DNA sections to be recognized and quantified, see for example page 19 and claims.

All of the structural and functional features have been described previously in the prior art, see D1-D3, and the problem of recognizing a methylation status has been solved previously in the prior art. No additional feature responsible for a surprising effect on the prior art can be found in the present application. The present set of claims therefore does not meet the requirements of PCT Article 33(3).

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Supplemental Box

In case the space in any of the preceding boxes is not sufficient.

Continuation of:

Box VIII

Claim 1 does not meet the requirements of PCT Article 6 because the subject matter for which protection is sought is not clearly defined. The claim attempts to define the subject matter in terms of the result to be achieved (hemimethylated double-stranded DNA, genomic), but in so doing merely states the problem to be solved without providing the technical features necessary for achieving this result. The same objection applies to claim 12. Furthermore, preparation of the hemimethylated double strands, starting from a genomic DNA sample, is not supported by the description (PCT Article 5).

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